

24. (Amended) The method of claim 18 [23], wherein the sweepstakes entry is pre-printed with identifying indicia. [paper entry form is pre-printed.]

### REMARKS

Claims 1-5, 7, 14-16, 18-22, and 24 remain in the application for further prosecution. Claims 6, 8-13, 17, 23, and 25-26 have been cancelled. Submitted herewith is a clean set of pending claims.

#### A. Claim Rejections – 35 U.S.C. § 102

Claims 1 and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,916,024 to Von Kohorn (“Von Kohorn”). The Office Action alleges that Von Kohorn discloses the invention. The Applicant respectfully disagrees on the basis that significant claim features are missing from Von Kohorn.

The Office Action cites the Von Kohorn patent for anticipating the present invention. Von Kohorn states (col. 154, lines 11-24):

*Organizers of the game or other participating parties, such as advertisers, frequently publish in-house journals containing free-standing inserts and coupons mailed to video game players. Coupons of this type can be coded or prenumbered. If a coupon is printed out and numbered in the course of a video game, a prize can be awarded to a player who has received a prize coupon and a mailed coupon whose numbers bear a predetermined correlation. A prize can be an entry into a sweepstake. Other kinds of contests and sweepstakes can be conducted by marketeers on computer communication networks for offering video game-related products and services. Trivia game contests can be held on-line as part of the services offered by such a computer communication network.*

Von Kohorn also states (col. 96, lines 11-18),

*The invention is applicable to the conducting of a large variety of games of chance including lotteries wherein players can participate in their homes and obtain entry tickets, such as in the form of the card 362, by way of example, directly in their homes. Furthermore, the players can pay for their wagers without leaving their homes, so that players who do not win do not have to leave their homes, and players who do win need make only one trip to a local sweepstakes agent at the redemption facility 906 to collect their winnings.*

The Von Kohorn patent is simply a means to receive a sweepstakes ticket, either through purchase or as a gift, at a remote location. In contrast, the present invention is a gaming machine, which in addition to offering a monetary payout, may also provide a player with a sweepstakes entry. (Claims 1 and 18). Amended Claim 1 reads as follows:

1. *(Thrice Amended) A method of playing a gaming machine, comprising:  
receiving a wager to initiate play of a game on the gaming machine;  
randomly selecting an outcome for the game from a plurality of possible outcomes;  
awarding a monetary payout from the gaming machine for a winning outcome;  
dispensing a tangible sweepstakes entry from the gaming machine in response to  
predetermined criteria;  
submitting the sweepstakes entry to enter the sweepstakes without involving the gaming  
machine; and  
conducting the sweepstakes after the sweepstakes entry is dispensed from the gaming  
machine.*

Claim 18 reads as follows.

18. *(Thrice Amended) A gaming machine, comprising:  
a credit receiving mechanism for receiving a wager to initiate play of a game on the  
gaming machine;  
a central processing unit for randomly selecting an outcome for the game from a  
plurality of possible outcomes;*

*means for awarding a monetary payout from the gaming machine for a winning outcome;  
a dispenser for dispensing a tangible sweepstakes entry in response to predetermined  
criteria; and*

*means for submitting the sweepstakes entry to enter a sweepstakes without involving the  
gaming machine, the sweepstakes being conducted after the sweepstakes entry is  
dispensed from the gaming machine.*

Claims 1 and 18 allow a player to make a wager on a gaming machine to play a game that can produce a monetary award. Von Kohorn describes a method to receive a sweepstakes ticket at a remote location. Applicant maintains that the missing elements, 1. wagering to initiate play on a gaming machine, and 2. the award of a monetary payout from the gaming machine, are novel and non-obvious features over Von Kohorn.

**B. Claim Rejections - 35 U.S.C. § 103**

Claims 1-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Von Kohorn '024 in view of Schneider '976.

**Kohorn and Schneider Do Not Contain Justification To Support Their Combination**

With regard to the proposed combination of Kohorn in view of Schneider, in order for any prior art references to be validly combined for use in a prior art 103 rejection, *the references themselves* must suggest that they be combined. The Applicant submits that neither Kohorn nor Schneider provide any suggestion of the advantages to be derived from the combination of their teachings, nor the desirability of making the combination, or any motivation for the combination. This is borne out by the disparate and unrelated problems that each reference attempts to overcome. Furthermore, none of the problems purportedly resolved by these references relate to the problems resolved by the present invention.

Von Kohorn describes a method to receive a sweepstakes ticket at a remote location. Von Kohorn states (col. 96, lines 11-18),

*. . . including lotteries wherein players can participate in their homes and obtain entry tickets, such as in the form of the card 362, by way of example, directly in their homes. Furthermore, the players can pay for their wagers without leaving their homes, so that players who do not win do not have to leave their homes, and players who do win need make only one trip to a local sweepstakes agent at the redemption facility 906 to collect their winnings.*

In contrast, the present invention provides a more entertaining gaming machine that in addition to offering a monetary award for a wager, may also award a player with a sweepstakes entry. The problem allegedly resolved by Von Kohorn for the remote delivery of a sweepstakes ticket is unrelated to the present invention. Consequently, there would be no reason to seek out the Von Kohorn patent for its teachings relating to the design of hardware that allows the remote delivery of sweepstakes tickets.

Similarly Schneider also resolves an unrelated problem; providing a more entertaining gaming machine. Schneider in its abstract describes,

*A gaming apparatus and method including a primary game and a player interactive bonus game actuated by a qualifying outcome of the primary game and including a bonus award display showing a multiplicity of images displayed on a video monitor from which a player selects until achieving a pair of matched bonus awards.*

Schneider provides a bonus game for standard slot type gaming machines and is unrelated to the present invention's method of using a gaming machine to award a player with a sweepstakes entry. Schneider is silent with respect to lotteries. Consequently, an ordinary artisan

would see no motivation or suggestion that would cause one skilled in the art to consult Schneider.

Furthermore, the problems Schneider attempts to solve are not related to the problems Von Kohorn attempts to resolve. Schneider purportedly offers a more entertaining gaming machine whereas Von Kohorn purportedly solves the problem of remote deliver of sweepstakes tickets. These problems are unrelated, and thus there is no motivation to seek out these references for their combination or modification. Consequently, Applicant maintains that the combination of references cited to form this rejection is improper.

**The Proposed Modification Renders The Prior Art Unsatisfactory For Its Intended Purpose**

It is improper to combine Von Kohorn and Schneider because such a proposed combination would render the Von Kohorn reference unsatisfactory for its intended purpose.

The intended purpose of the Von Kohorn patent is to allow the remote delivery of sweepstakes tickets. An individual may purchase a sweepstakes entry ticket as taught by Von Kohorn (col. 96, lines 11-18),

*wherein players can participate in their homes and obtain entry tickets, ... directly in their homes. Furthermore, the players can pay for their wagers without leaving their homes, so that players who do not win do not have to leave their homes*

An individual may also be gifted a sweepstakes as taught by Von Kohorn (col. 154, lines 15-19),

*If a coupon is printed out and numbered in the course of a video game, a prize can be awarded to a player who has received a prize coupon and a mailed coupon whose numbers bear a predetermined correlation. A prize can be an entry into a sweepstake.*

The intended purpose of Schneider is to provide a more entertaining game for a gaming machine. Schneider is described in its abstract as,

*A gaming apparatus and method including a primary game and a player interactive bonus game actuated by a qualifying outcome of the primary game and including a bonus award display showing a multiplicity of images displayed on a video monitor from which a player selects until achieving a pair of matched bonus awards.*

The Office Action on page 3 alleges that the Von Kohorn patent discloses the invention, except for,

*the predetermined criteria include the selected outcome being a predetermined one or more of the plurality of possible outcomes...and receiving a wager to initiate play of the game and randomly selecting an outcome from a plurality of possible outcomes.*

The Office Action further states (page 3-4) that,

*it would have been obvious to ...**modify Von Kohorn to include a gaming machine** having an outcome being a predetermined one or more of the plurality of possible outcomes, . . . receiving a wager to initiate play of the game and randomly selecting an outcome from a plurality of possible outcomes as taught by Schneider.*

The modification suggested by the Office Action would result in a gaming machine on which a player makes a wager that potentially triggers a bonus game (as described in Schneider), which allows a player to remotely purchase, or be gifted, a sweepstakes ticket (as described in Von Kohorn). However, the proposed modification would undermine the intended purpose of the Von Kohorn reference.

The proposed modification would force an individual to wager on a slot machine game (i.e., the base game) before potentially receiving a sweepstakes entry. The Office Action's proposed modification would only give a player a **chance to purchase a sweepstakes ticket**

after a wager has been placed on the base game. This would make the Von Kohorn prior art reference unsatisfactory for its intended purpose as a direct means to sell and deliver sweepstakes tickets to a remote location.

Furthermore, even if Von Kohorn intends only to gift a sweepstakes ticket, the proposed modification would still force the player to place a wager for a chance to win a sweepstakes ticket. The proposed modification would result in a wagering game making the Von Kohorn prior art unsatisfactory for its intended purpose of providing a non-wagering game that gifts sweepstakes tickets as a promotional marketing tool.

The Applicant maintains that the proposed modification would make Von Kohorn inoperable for its intended purposes. Consequently, the proposed references cannot be combined to render the claims *prima facie* obvious.

### **The Proposed Modification Changes The Reference's Principle Of Operation**

It is improper to combine Von Kohorn and Schneider because such a proposed combination would change the Von Kohorn reference's principle of operation.

Von Kohorn's principle of operation is to allow an individual to either purchase or be gifted a sweepstakes ticket at a remote location. An individual may purchase a sweepstakes entry ticket, as taught by Von Kohorn (col. 96, lines 11-18),

*wherein players can participate in their homes and obtain entry tickets, ... directly in their homes. Furthermore, the players can pay for their wagers without leaving their homes, so that players who do not win do not have to leave their homes.*

An individual may also be gifted a sweepstakes as taught by Von Kohorn (col. 154, lines 15-19),

*If a coupon is printed out and numbered in the course of a video game, a prize can be awarded to a player who has received a prize coupon and a mailed coupon whose numbers bear a predetermined correlation. A prize can be an entry into a sweepstake.*

Schneider's principle of operation is a wagering game. Schneider is described in its abstract as,

*A gaming apparatus and method including a primary game and a player interactive bonus game actuated by a qualifying outcome of the primary game*

The Office Action on page 3 alleges that the Von Kohorn patent discloses the invention, except for,

*the predetermined criteria include the selected outcome being a predetermined one or more of the plurality of possible outcomes...and receiving a wager to initiate play of the game and randomly selecting an outcome from a plurality of possible outcomes.*

The Office Action states on pages 3-4,

*it would have been obvious to ...**modify Von Kohorn to include a gaming machine** having an outcome being a predetermined one or more of the plurality of possible outcomes, . . . receiving a wager to initiate play of the game and randomly selecting an outcome from a plurality of possible outcomes as taught by Schneider.*

The modification suggested by the Office Action would result in a gaming machine on which a player makes a wager that potentially triggers a bonus game (as described in Schneider), which allows a player to remotely purchase, or be gifted, a sweepstakes ticket (as described in Von Kohorn). However, the proposed modification would change the principle of operation of the Von Kohorn reference.

The proposed modification would force an individual to wager on a slot machine game (i.e., the base game) before potentially receiving a sweepstakes entry. The Office Action's



proposed modification would only give a player a **chance to purchase a sweepstakes entry ticket** after a wager has been placed on the base game. This would change the principle of operation of the Von Kohorn reference from a direct means to sell sweepstakes entry tickets to a wagering game wherein a player only has a chance to win a sweepstakes entry ticket.

Furthermore, even if Von Kohorn intends only to gift a sweepstakes ticket, the proposed modification would still force the player to place a wager for a chance to win a sweepstakes ticket. The proposed modification would result in a wagering game, the antithesis of Von Kohorn's gifting of sweepstakes entry tickets, and changing Von Kohorn's principle of operation.

The Applicant maintains that the suggested modification/combination of Von Kohorn in view of Schneider would require a substantial reconstruction and redesign of the primary reference (Von Kohorn), as well as change the basic operating principle under which the primary reference operates. As the proposed modification would change the principle of operation of the Von Kohorn reference, the proposed references cannot be combined to render the claims *prima facie* obvious.

## Conclusion

It is the Applicant's belief that all of the claims are now in condition for allowance, and action towards that end is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,



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